

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action, dated August 19th, 2005, in which: claims 1-19, 22-26, 28-39, and 41-68 are rejected under 35 U.S.C 103(a) as being obvious over Chmaytelli (U.S. Patent No. 6,233,464, hereinafter "Chmaytelli"); and claims 20, 21, 27, 40 and 69 are rejected under 35 U.S.C 103(a) as being unpatentable over Chmaytelli in view of Nakamura (U.S. Patent No. 6,085,096). These rejections are respectfully traversed.

It is noted that in order to establish *prima facie* obviousness, there must be some suggestion or motivation to modify or combine reference teachings, and the modification or combination, if successful, must teach or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." It is respectfully submitted that the cited reference does not meet these criteria, and, therefore, the Examiner has improperly rejected the pending claims. For example, Chmaytelli does not teach or suggest all of the claim limitations, as set forth in MPEP § 2142/2143, and the Examiner has made no showing that all of the claim limitations are present in Chmaytelli, either expressly or inherently. There is at least one element of the rejected claims absent in Chmaytelli, and, additionally, the Examiner has provided no showing that the at least one missing element is inherent, such as by showing that the at least one missing element is necessarily present in the cited art.

Assignee begins with claim 1. The Examiner, in the Office Action, page 2, states, "In this case, since other options may be offered as required, can be set by the user...it is obvious that the system of Chmaytelli is capable of providing a second mode of operation in which the communication functionality is disabled and the local functionality is enabled." However, Assignee is unable to locate any description that supports "a switch, coupled to a power supply and to the computing unit, to

selectively couple the radio communication unit to the power supply, to provide first and second modes of operation, wherein the first mode of operation enables the computing unit and the radio communication unit, and the second mode of operation disables the radio communication unit and enables the communication unit." As recited in claim 1. Therefore, because Chmaytelli does not teach or suggest all the claim limitations as set forth in MPEP § 2142/2143, a successful 35 U.S.C 103(a) rejection has not been made. It is, therefore, respectfully submitted that claim 1 is in condition for allowance.

Additionally, claims 2-8 either depend from or include all limitations of claim 1, and claims 2-8 are not rendered obvious for at least the same reasons as presented above. It is respectfully requested that the Examiner withdraw his rejection to these claims.

Referring now to claim 9, Chmaytelli does not show or describe at least "providing a first mode of operation in which both wireless communication functionality and local functionality of the device are enabled; providing a second mode of operation in which the communication functionality is disabled and the local functionality is enabled; and selectively switching between the first and second modes of operation.", as recited in claim 9. According to the Examiner, on page 2 of the Office Action, "It is obvious that the system of Chmaytelli is capable of providing a second mode of operation in which the communication functionality is disabled and the local functionality is enabled". However, Assignee is unable to locate any portion of Chmaytelli that shows or describes such a mode of operation. Therefore, because Chmaytelli does not teach or suggest all the claim limitations as set forth in MPEP § 2142/2143, a successful 35 U.S.C 103(a) rejection has not been made. It is, therefore, respectfully submitted that claim 9 is in condition for allowance.

Additionally, claims 10-19, 22-26, 28-39 and 41-68 either depend from or include limitations similar to those of claims 1 and/or 9, and, therefore, are not rendered obvious for at least the same reasons as presented above with reference to claims 1 and/or 9. It is respectfully requested that the Examiner withdraw his rejection of these claims.

Referring now to claim 20, it is respectfully submitted that this claim is not rendered obvious by Chmaytelli in view of Nakamura. The Examiner concedes that Chmaytelli does not recite at least one element of claim 20. According to the Examiner, on page 12 of the Office Action, "Chmaytelli fails to

teach that the external entity triggers the selection means to select between the first and second modes of operation." Although Assignee does not agree with the Examiner's characterization of claim 20, it is respectfully submitted that Nakamura fails to cure this deficiency noted by the Examiner.

As just an example, none of Chmaytelli or Nakamura, either alone or in combination show or describe at least "a first means for providing local functionality; a second means for providing communication functionality; and a selection means for selecting between a first mode of operation, wherein both the local functionality and the communication functionality are provided, and a second mode of operation, where the local functionality is provided and the communication functionality is disabled." As recited in claim 20. Nakamura is directed toward a mobile communication system which may restrict the use of mobile station radio units. There is no mention throughout Nakamura of "a second mode of operation, where the local functionality is provided and the communication functionality is disabled." Therefore, neither of Chmaytelli and Nakamura teach or suggest all the claim limitations, as set forth in MPEP § 2142/2143. Therefore, a successful 35 U.S.C 103(a) rejection has not been made, and it is respectfully submitted that claim 20 is in condition for allowance.

Claims 21, 27, 40, and 69 distinguish from the cited art for reasons similar to those presented with respect to claim 20. For example, neither Chmaytelli nor *Nakamura* show or describe "a second mode of operation, where the local functionality is provided and the communication functionality is disabled." Because claims 21, 27, 40, and 69 distinguish for reasons similar to those presented with respect to claim 20, it is respectfully requested that the Examiner withdraw his rejection of these claims.

Assignee respectfully submits that, for at least the reasons presented above, a prima facie case of obviousness has not been established, and, therefore, claims 1-69 are in a condition for allowance. It is noted that many other bases for traversing the rejections could be provided, but Assignee believes that these grounds are sufficient. It is respectfully requested that the Examiner withdraw his rejections of claims 1-69.

CONCLUSION

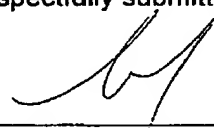
In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Dated: _____

1/9/06

Respectfully submitted,



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